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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/605,802	10/28/2003	Paul D. SCHLUNT	06472.0043.NPUS00	2801
22446	7590	09/12/2007		
ICE MILLER LLP ONE AMERICAN SQUARE, SUITE 3100 INDIANAPOLIS, IN 46282-0200			EXAMINER BASHORE, ALAIN L	
			ART UNIT 1762	PAPER NUMBER
			MAIL DATE 09/12/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/605,802		SCHLUNT ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Alain L. Bashore		1762	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 June 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 44-59 is/are pending in the application.
- 4a) Of the above claim(s) 57-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 44-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Composition claims 1-43 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 6-27-07.

2. Newly submitted claims 57-59 appear to be directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 57-59 are composition claims and composition was non-elected without traverse hence withdrawn from further consideration.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 57-59 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Specification***

3. The use of the trademarks through out the specification has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Art Unit: 1762

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

***Information Disclosure Statement***

4. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited (by the examiner) on form PTO-892, they have not been considered.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 44-47, 51-54, 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta et al in view of Walters et al in further view of Bhalakia et al ('446).

Art Unit: 1762

Gupta et al discloses a method of preparing a photocromic polycarbonate lens. The method comprises providing a polycarbonate lens blank, applying a coating composition to the lens blank to form a coating layer, partially polymerizing the coating layer, applying a photochromic matrix layer to the coating layer; then polymerizing the tie coating layer and the photochromic matrix layer to prepare and remove a photochromic polycromic lens from the mold. The coating composition may be applied by spin coating. There is disclosed acrylates and photochromic dyes (col 2, lines 5-11, 43-46, 58-67; col 3, lines 1-5, 59-43; col 4, lines 20-26, 45-50).

Regarding the recitation of "tie" as applicant claims for their coating composition, such would be considered inherently a "tie" composition for the prior art Gupta since there is an adhesive function thus performing the same.

Gupta et al does not disclose:

- a urethane matacrylate oligomer in either the coating composition or photocromic matrix layer composition;
- drying the lens blank by heating with dry air;
- the coating layer of about 8-16 microns in thickness; and
- allowing a solvent in the coating composition to evaporate to form the coating layer.

Art Unit: 1762

Walters et al discloses urethane matacrylate oligomers for use in photochromic compounds, drying the lens blank by heat with dry air, and a coating layer of about 8-16 microns in thickness (col 1, lines 60-67; col 2, lines 43-50; col 8, line 28).

It would have been obvious to one with ordinary skill in the art to include urethane matacrylate oligomers for use in the coating composition and photochromic composition because Walters teaches polymerization for methacrylates.

It would have been obvious to one with ordinary skill in the art to include drying the lens blank by heat with dry air because Walter teaches improved adhesion ability (col 1, lines 60-61).

It would have been obvious to one with ordinary skill in the art to include a coating layer of about 8-16 microns in thickness because Walters teaches adequate mechanical film properties (col 2, lines 45-50).

Bhalakia et al discloses allowing a solvent in the coating composition to evaporate to form a coating layer (col 23, lines 39-47).

Art Unit: 1762

It would have been obvious to one with ordinary skill in the art to include allowing a solvent in the coating composition to evaporate to form the coating layer because Bhalakia et al teaches functional film formation and polycarbonate lens.

7. Claims 48-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta et al in view of Walters et al in further view of Bhalakia et al ('446) as applied to claims above, and further in view of Tanaka et al.

Tanaka et al discloses UV light exposure within the range claimed in claims 48-49 of applicant (para 0053).

It would have been obvious to one with ordinary skill in the art to include UV light exposure within the range claimed in claims 48-49 because Tanaka et al teaches polymerization by radiation, as is disclosed by Gupta et al.

8. Claim 55 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta et al in view of Walters et al in further view of Bhalakia et al ('446) as applied to claims above, and further in view of Smith et al.

Smith et al discloses a gasket having a seal when place in the mold (col 20, lines 28-31).

It would have been obvious to one with ordinary skill in the art to include the recitation of claim 55 because Smith et al discloses lens formation by a mold.

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alain L. Bashore whose telephone number is 571-272-6739. The examiner can normally be reached on about 7:30 am to 5:00 pm (Mon. thru Thurs.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alain L. Bashore/  
Primary Examiner  
Art Unit 1762